

Application No. 09/936,930

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June 8, 2004

Reply Under 37 C.F.R. § 1.111 and

Submission with RCE UNDER 37 C.F.R. § 1.114

REMARKS

Applicants thank the Examiner for the courtesies extended to Applicants' representative during the Interview of March 10, 2004. Applicants believe that the Interview has advanced prosecution of the present application.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims. In the present Reply, claims 2, 3, 8, 22 and 23 have been amended. Claims 4-7 and 9-21 have been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 1, 5-7 and 9-19 have been withdrawn from consideration. Thus, claims 1-3, 8 and 22-23 are pending in the present application.

No new matter has been added by way of these amendments, because each amendment to claims 2-3 merely incorporate the canceled subject matter, and is further supported by the present specification at page 3, line 25 to page 4, line 21, pages 19-21, page 27, line 19 to page 28, line 3, and page 29, lines 1-17. With the amendments to these claims, claims 8, 22, and 23 were appropriately amended. Thus, no new matter has been added.

Based upon the above considerations, entry of the present Reply is respectfully requested.

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In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Substance of the Interview

In accordance with M.P.E.P. § 713.04, Applicants provide the following.

During the March 10, 2004, Interview, Applicants proposed amending claims 2 and 3 as presented herein, and the Examiner agreed to reconsider the present invention in view of the claims as presented and with regard to the outstanding rejections. Applicants also submitted arguments as to how the present invention, including the embodiments corresponding to pending claims 2 and 3, distinguishes over the cited Japanese reference. These distinctions are discussed in more detail below.

Comments in the Advisory Action

With regard to paragraph 1, page 2 of the Advisory Action of May 3, 2004, Applicants respectfully refer the Examiner to the marker for claim 3 as presented.

With regard to paragraph 2 of the Advisory Action, the disputed claims have been canceled.

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With regard to paragraph 3 of the Advisory Action, Applicants respectfully request the Examiner to withdraw all relevant rejections with regard to claims 2 and 3 as presented. Further, Applicants respectfully request the Examiner to consider the full scope of all claims. In addition, Applicants respectfully submit that the scope of each of the instantly pending claims is clearly defined, wherein the recitation of "comprises" is clear to one having skill in the art. Finally, with regard to claim 22, Applicants respectfully refer the Examiner to page 19, starting at line 23 of the present specification for clarification purposes.

With regard to paragraph 4 of the Advisory Action, Applicants are aware of the provisions of M.P.E.P. § 2173.05(i). However, Applicants respectfully maintain their position that there is sufficient description of claimed features of the present invention for the reasons stated below. Further, M.P.E.P. § 2173.05(i) states: "Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support." (citing *Ex parte Parks*). Each case is decided on its own facts, and the present specification gives ample Examples that do not have the feature as recited. Thus, Applicants respectfully submit that there is no *prima facie* case for lack of descriptive support with regard to the claim language "excluding a foaming pressure sensitive adhesive

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layer". Reconsideration and withdrawal of the rejection (addressed below) are respectfully requested.

Issues Under 35 U.S.C. § 112, First Paragraph (Enablement)

Claims 2-4, 8 and 20-23 stand rejected under 35 U.S.C. § 112, first paragraph, for asserted lack of enablement (see paragraph 5 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal thereof are respectfully requested.

Applicants respectfully refer the Examiner to the scope of the presented claims.

As can be seen, the disputed claims recite structural/chemical features (i.e., types of adhesives; proportions of monomers; etc.) that enable the present invention.

Also, as can be seen from claim 2 or 3, the presently claimed pressure-sensitive adhesive sheet sticks to an article to be cleaned, and then is peeled off the article. This action also removes a solvent-containing substance (and solvent) to be removed. Thus, when Applicants claim that the pressure-sensitive adhesive layer "absorbs 5 g/m² or more of a solvent contained in the substance" when the sheet is immersed in the solvent for 1 second, this refers to an absorption rate for removing a predetermined amount of solvent in a second. Applicants' position is further supported by page 29, lines 1-17 of the present specification.

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Further, it is clear that the presently claimed pressure-sensitive adhesive sheet requires a certain amount of tackiness (3 cN/25-mm or more) after the sheet absorbs the solvent.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Issues Under 35 U.S.C. § 112, First Paragraph (Written Description)

Claims 2, 8 and 20-23 stand rejected under 35 U.S.C. § 112, first paragraph, for asserted lack of written description (see paragraph 6). Applicants respectfully traverse.

Applicants first submit that "the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner." *Ex parte Parks*, 30 USPQ2d 1234, 1236 (citing *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992)); see also *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Here, Applicants respectfully submit that the burden of proving patentability has not shifted to Applicants. This is because page 21, line 18 to page 22, line 15 of the present specification describes foaming agents.

Further, even assuming *arguendo* that the burden has shifted, Applicants respectfully submit that many examples in the present specification do not use a foaming agent. In particular, Applicants respectfully refer the Examiner to at least the first several examples

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(Example 1 starts at page 57) of the present specification. Coupled with these many Examples, Applicants respectfully refer the Examiner to *Ex Parte Parks*, which cites *Ex Parte Grasselli*, in support of their position. 30 USPQ2d 1234, 1236 (BPAI 1993) (Claims in reissue application for method of determining nitrogen content of sample were improperly rejected on ground of inadequate descriptive support under 35 USC 112, first paragraph, since originally-filed disclosure need only convey, to one of skill in art, that applicant had possession of concept of what is claimed in order to satisfy description requirement, since lack of literal basis in disclosure for limitation that decomposition step of claims be "conducted in the absence of a catalyst" thus does not establish *prima facie* case for lack of descriptive support, and since it cannot be held that originally-filed disclosure would not have conveyed concept of effecting decomposition at elevated temperature in absence of catalyst) (citing *In re Anderson*, 176 USPQ 331 (CCPA 1973)). Based on the present specification and the Examples, there are multiple instances of not including a foaming pressure sensitive adhesive layer. Thus, the concept of excluding the foaming pressure sensitive adhesive layer is within Applicants' invention. Accordingly, Applicants respectfully submit that Applicants have sufficient written description of their invention and that the Examiner has not established that the original disclosure would

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not have reasonably conveyed to one having ordinary skill in the art that Applicants had possession of the now claimed subject matter.

In addition, Applicants respectfully submit that the proper perspective for this issue under § 112, first paragraph, is from one having skill in the art. In fact, under U.S. case law, an exact, verbatim description is not necessary. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); see also *Eiselstein v Frank*, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) ("the 'written description' requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims"; citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116; see also *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) ("[L]ack of literal support . . . is not enough . . . to support a rejection under Section 112."). Here, one skilled in the art would recognize that the present inventors possessed the claimed adhesive sheet invention at the time of filing.

Thus, based on the above comments and case law (i.e., *Ex Parte Parks*), Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

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Issues Under 35 U.S.C. § 112, Second Paragraph

Claims 2, 8 and 20-23 stand rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness. This rejection respectfully is traversed to the extent deemed to apply to the claims as amended.

As mentioned previously, the presently claimed pressure-sensitive adhesive sheet sticks to an article to be cleaned, and then is peeled off the article. Further, the pressure-sensitive adhesive layer absorbs a certain amount of solvent contained in the substance when the sheet is immersed in the solvent, and requires a certain amount of tackiness after the sheet absorbs the solvent. Thus, Applicants respectfully submit that the pending claims recite clear and definite claim language. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 2, 8 and 20-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admitted prior art. This rejection is respectfully traversed. Such prior art is believed to be comprised of JP 3-74893, JP 6-297681, and JP 590114055. Further, the Examiner appears to consider JP 3-74893 as the closest prior art (see the Office Action in the paragraph bridging pages 6-7). Reconsideration and withdrawal of this rejection is requested.

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As mentioned in Applicants' previous reply, the JP 3-74893 (JP '893) reference discloses an adhesive layer having an adhesion or tack of from 100 to 300 g/25-mm. However, Applicants respectfully submit that this disclosure of amount of tack refers to initial tackiness. Further, the described amount of initial tackiness does not relate to the absorption characteristics of the adhesive sheet, nor does this disclosure relate to the tackiness of the sheet after the sheet has absorbed a certain amount of solvent. Thus, Applicants respectfully submit that the cited JP '893 reference fails to disclose an absorption of "5 g/m² or more of a solvent contained in the substance to be removed when the pressure-sensitive adhesive sheet is immersed in the solvent for 1 second" nor does this reference disclose or recognize an amount of tackiness of "3 cN/25-mm or more" as instantly claimed.

In support of Applicants' position, Applicants respectfully refer the Examiner to Example 5 of the present specification (starting at page 63). In Example 5, the pressure-sensitive adhesive sheet has an initial tackiness of 140 cN/25-mm (140 gf/25-mm), a solvent absorption per unit area of 10 g/m², and a tackiness of 5 cN/25-mm (5 gf/25-mm) after absorption of 5 g/m² of the solvent (which fully removes a paste turned about the back of the plate). In comparison, Comparative Example 3 has its pressure-sensitive adhesive sheet with an initial tackiness of 110 cN/25-mm (110 gf/25-mm) (see the JP '893 reference disclosing a range of

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100-300 g/25-mm for initial adhesion), a solvent absorption per unit area of 9 g/m², and a tackiness of 0 cN/25-mm (0 gf/25-mm) after absorption of 5 g/m² of the solvent. The tackiness value after absorption reflects how this sheet of Comparative Example 3 cannot fully remove a paste turned about the back.

In other words, Comparative Example 3 clearly shows a pressure-sensitive adhesive sheet may have a certain amount of initial tackiness, but that such initial tack has no relation to the solvent absorption or tackiness thereafter as instantly claimed. Applicants submit that JP '893 even corresponds to Comparative Example 3 of this application's present specification, wherein the adhesive layer absorbs a solvent in a paste but significantly or completely loses its tackiness thereafter. Comparative Example 3 cannot remove the turned-about paste.

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to the cited references since not all requirements for a *prima facie* case of obviousness have been satisfied. The JP '893 reference does not even describe all features as instantly claimed (*i.e.*, the amount of tackiness after solvent absorption), which is a requirement for establishing a *prima facie* case of obviousness. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); see also *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). Thus, the initial

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requirement of disclosure of all claimed features has not been satisfied.

Applicants also submit that the skilled artisan would not know how to modify the JP '893 reference in order to achieve the present invention since there is no guiding disclosure to achieve the absorption characteristics or tackiness after absorption as instantly claimed. Thus, Applicants respectfully submit that the other requirements for a *prima facie* case of obviousness have also not been satisfied.

Accordingly, Applicants submit that each of the cited references, including JP '893, fails to disclose all features as instantly claimed. Further, there is no relationship between a described initial tackiness and the "absorption of the solvent" or "tackiness after absorbing" of an adhesive sheet. Such differences are clearly shown in Applicants' Examples and Comparative Examples of the present specification. Accordingly, reconsideration and withdrawal of all rejections are respectfully requested.

JP 10-180991

Applicants submit that the following information regarding the disclosure of the article "F1000" at paragraph [0039], page 6, of the translation in JP 10-180991.

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| Properties of "F1000" | |
|-------------------------------------|---|
| Thickness of the adhesive layer | 80µm |
| Pressure-sensitive adhesives | Acrylic pressure-sensitive adhesives composed of a copoly (butyl acrylate/acrylic acid)=PAB |
| Composition of the adhesive layer | PAB/crosslinking agent/foaming agent (weight ratio: 100/3/5) |
| Solvent absorption per unit area | 20.4 g/m ² |
| Tackiness after absorbing a solvent | 17cN/25-mm |

Applicants respectfully request consideration of the disclosure of the JP '991 reference.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, or in an effort to advance prosecution, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an

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interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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